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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/623,481	09/14/2000	Toshio Yamagiwa	P107348-0004	2402

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WASHINGTON, DC 20036

EXAMINER

FISCHER, JUSTIN R

ART UNIT	PAPER NUMBER
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1733

10

DATE MAILED: 06/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

09/623,481

Applicant(s)

YAMAGIWA, TOSHIO

Examiner

Justin R Fischer

Art Unit

1733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2 and 4-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2, 6 and 7 is/are allowed.
- 6) ☒ Claim(s) 4, 5 and 8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 4 and 8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 2 of copending Application No. 09/585,402 in view of von Arx. US Serial Number 09/585,402 and von Arx are applied in the same manner as set forth in Paper Number 11, Paragraph 5.

Claim 1 of US Serial Number 09/585,402 is directed to a method of forming a "sealant-incorporated" tire in substantially the same manner as that disclosed by the claimed invention. Although claim 1 of 09/585,402 generically defines the location as "between adjacent tire materials", one of ordinary skill in the art at the time of the invention would have readily appreciated the language "between adjacent tire materials" as being directed towards the formation of a sealant chamber in accordance to the limitations of the claimed invention (regarding location of sealant chamber) as it is extremely well known and conventional to form sealant chambers between the

Art Unit: 1733

innerliner and the tire body. Although 09/585,402 is silent with respect to the use of a water soluble paper or non woven fabric, one of ordinary skill in the art at the time of the invention would have readily appreciated the use of a wide variety of materials such that they possessed the ability to be dissolved in a given sealant composition. In particular, since it is well known in the tire industry that sealant compositions contain water, one of ordinary skill in the art at the time of the invention would have been motivated to select a water soluble material and as evidenced by von Arx, water soluble paper or non woven fabrics are known to be used between adjacent materials due to their ability to disintegrate or dissolve as desired. Thus, absent any unexpected results, the selection of a water soluble paper or non woven fabric as the anti-adhesive sheet would have been obvious to one of ordinary skill in the art at the time of the invention, as set forth above.

This is a provisional obviousness-type double patenting rejection.

3. Claims 5 and 8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4 and 8 of copending Application No. 09/585,402 in view of Suzuki. US Serial Number 09/585,402 and Suzuki are applied in the same manner as set forth in Paper Number 11, Paragraph 6.

In this instance, claim 2 of 09/585,402 describes a method of forming a tire that is substantially the same as that required by the claimed invention. Although claim 2 of 09/585,402 generically defines the location as "between adjacent tire materials", one of ordinary skill in the art at the time of the invention would have readily appreciated the

Art Unit: 1733

language "between adjacent tire materials" as being directed towards the formation of a sealant chamber in accordance to the limitations of the claimed invention (regarding location of sealant chamber) as it is extremely well known and conventional to form sealant chambers between the innerliner and the tire body. Additionally, the anti-adhesive sheet of 09/585,402 is formed of a water soluble film. While 09/585,402 is completely silent with respect to the use of a polysaccharide film, one of ordinary skill in the art at the time of the invention would have recognized that polysaccharide films are well known water soluble films that are commonly used between adjacent substrates due to their ability to prevent sticking and their ability to dissolve in water or water-containing compositions, as evidenced by Suzuki. Thus, the selection of a polysaccharide film as the anti-adhesive material would have been well within the purview of one of ordinary skill in the art at the time of the invention in view of the teachings of 09/585,402, directed to the use of a water soluble film, and Suzuki, which evidences the common use of polysaccharide films due to their release properties (anti-adhesive characteristics) and water-soluble properties.

This is a provisional obviousness-type double patenting rejection.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 1733

5. Claims 4 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior invention of US Serial Number 09/585,402 and further in view of von Arx (US 3,096,202). US Serial Number 09/585,402 and von Arx are applied in the same manner as set forth in Paper Number 11, Paragraph 2. The present invention and 09/585,402 have different inventive entities but share a common inventor (Yamagiwa). Since 09/585,402 has been allowed to proceed to allowance first, it is presumed that the present invention was derived therefrom. Although 09/585,402 has a shared assignee with the present invention, the respective applications have different assignees. Therefore, 09/585,402 is available as prior art under 102(f).

US Serial Number 09/585,402 is directed to a method of forming a "sealant-incorporated" tire in substantially the same manner as that disclosed by the claimed invention. One of ordinary skill in the art at the time of the invention would have recognized that the critical feature of the anti-adhesive sheet in 09/585,402 is the capability of being dissolved in a given sealant composition. Although 09/585,402 does not expressly describe the anti-adhesive sheet as being formed of a water soluble paper or nonwoven fabric, one of ordinary skill in the art at the time of the invention would have readily appreciated the selection of many materials, including the presently claimed water soluble paper or nonwoven fabric, for the anti-adhesive sheet, depending on the composition of the sealant. This is especially true in view of von Arx (Figure 2 and Column 2, Lines 1-5), which illustrates the use of water soluble paper or non-woven fabric (i.e. tissue paper) in articles where the dissolution of the tissue is desired.

Art Unit: 1733

6. Claims 5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over 09/585,402 as applied to the rejections of claims 4 and 8 above and further in view of Suzuki (JP 09155881). US Serial Number 09/585,402 and Suzuki are applied in the same manner as set forth in Paper Number 11, Paragraph 3.

US Serial Number 09/585,402 is directed to a method of forming a "sealant-incorporated" tire in substantially the same manner as that disclosed by the claimed invention. One of ordinary skill in the art at the time of the invention would have recognized that the critical feature of the anti-adhesive sheet in 09/585,402 is the capability of being dissolved in a given sealant composition, particularly a water soluble film. Although 09/585,402 fails to suggest the use of a film formed of natural polysaccharide, such a material represents a well known water soluble film that is commonly used as a release agent (i.e. prevents sticking to mold) between adjacent substrates due to its water soluble property. For example, Suzuki evidences the use of a polysaccharide film between a mold and a resin composition, wherein dipping into a water bath after the molding step dissolves the polysaccharide film. One of ordinary skill in the art at the time of the invention would have readily appreciated the use of a polysaccharide film (water soluble film) since it is well known that such films are used between adjacent substrates to prevent sticking, while being dissolvable in water or water-containing compositions.

***Allowable Subject Matter***

7. Claims 2, 6, and 7 are allowed. The following is an examiner's statement of reasons for allowance: There was no reference in the prior art search that suggested a

Art Unit: 1733

method of forming a "sealant incorporated" tire comprising the steps of placing an anti adhesive sheet between an innerliner and a tire body and subsequently injecting a sealant composition into the region or chamber created by the anti adhesive sheet, such that (a) only a portion of the anti adhesive sheet is formed with the anti adhesive property and the no-containing portion bonds to the wall of the chamber during vulcanization, (b) the anti adhesive sheet is formed of a plurality of sheets laminated one on top of the other, or (c) the anti adhesive sheet is corrugated in order to facilitate the expansion of said anti adhesive sheet during vulcanization.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### ***Response to Arguments***

8. Applicant's arguments filed April 16, 2003 have been fully considered but they are not persuasive.

The obviousness-type double patenting rejection stands because no proper terminal disclaimer has been filed. Applicant's argument that the obviousness-type double patenting rejection should be withdrawn since Ishikawa et al. is not available as prior art under 35 U.S.C § 102 or 103 is irrelevant because obviousness-type double patenting is based on a judicially created doctrine grounded in public policy instead of being based on the availability of a reference as prior art under 102 or 103.



Art Unit: 1733

Regarding the rejections under 35 U.S.C. § 103, applicant argues that Ishikawa et al. does not qualify as prior art under either sections 102 or 103 based on the priority dates of the Japanese applications. While Ishikawa et al. is not applicable under 35 U.S.C. § 102 (a), 102(b), and 102 (e), it is believed that the disclosure of Ishikawa et al. is applicable under 35 U.S.C. §102 (f), as set forth in Paper Number 11, Paragraph 2. In particular, applicant has not provided evidence as to why Ishikawa et al. is not available under 35 U.S.C. §102 (f).

### ***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Justin R Fischer** whose telephone number is **(703) 605-4397**. The examiner can normally be reached on M-F (7:30-4:00).

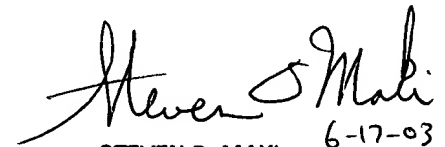
Art Unit: 1733

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Ball can be reached on (703) 308-2058. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

  
Justin Fischer

June 17, 2003

  
STEVEN D. MAKI  
PRIMARY EXAMINER  
GROUP 1300  
AV 1733  
6-17-03